



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/681,587      | 10/07/2003  | Thomas L. Barnhart   | 170707-1016         | 6858             |

|                               |      |            |
|-------------------------------|------|------------|
| 24973                         | 7590 | 08/10/2007 |
| LAW OFFICE OF SANFORD J ASMAN |      |            |
| 570 VININGTON CT              |      |            |
| ATLANTA, GA 30350-5710        |      |            |

|                 |  |
|-----------------|--|
| EXAMINER        |  |
| JANVIER, JEAN D |  |

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 3622     |              |

|            |               |
|------------|---------------|
| MAIL DATE  | DELIVERY MODE |
| 08/10/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/681,587 | <b>Applicant(s)</b><br>BARNHART ET AL. |  |
|                              | <b>Examiner</b><br>Jean Janvier      | <b>Art Unit</b><br>3622                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 3622

### **Response To Applicant's Arguments**

All the Applicant's potential arguments are herein being moot in view of new ground of rejection.

Further, receipt of a Terminal Disclaimer, filed under 1.321 to thereby overcome a potential Obviousness Double Patenting Rejection, disclaiming the terminal part of the statutory term of any patent granted on the Instant Application, which would have extended beyond the expiration date of the full statutory term of prior patent No. 6, 629,888 is herein being acknowledged.

### **DETAILED ACTION**

#### ***Specification***

#### ***Claim Status***

Claims 1-8 are pending in the Instant Application.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Ray, Debra, in an article "FASTBALL.com's" "Decode & Win Game" ", published on November 1997 (Dialog 01539026 01-90014).

As per claims 1-8, Ms. Ray describes, in the article, that FASTBALL.com's Decode &

Art Unit: 3622

Win Game proved that a compelling promotion can not only generate trial, but also bring repeat visitors or players to an online service or website **in order to increase traffic at the said web site (reading on the step of providing a website at which a game is being played, a product promotion is being conducted....).**

Further, in the article, Ms. Ray continues by pointing out that the marketing dilemma of the 1990s was: How can producers of a new Internet Web site get people or visitors to try it or to visit it to thereby increase traffic at the said website? (Same problem as the one this Application is trying to solve). Here, to address this problem or dilemma, Cox Interactive Media's FASTBALL.com had completed a four-week promotion that set new benchmarks for on-line/Internet promotions.

In fact, a direct mail campaign to a test cell of 7,000 FASTBALL.com users generated had interest or participation in excess of 40 percent (increasing traffic at the featured site by 40 percent). Compared to national direct mail response rates that usually average in the one to five percent range, FASTBALL.com's "Decode & Win Game" promotion had proved that a compelling (product) promotion can not only generate trial or interest, but also bring repeat visitors to an on-line service (website). In general, the direct had invited the visitors (site users) or potential players to visit the website and participate in a promotional game (sweepstakes entry) by using a provided game indicia (game piece).

#### About the Game:

Indeed, "The Promotions Unlimited, Inc.", an Atlanta-based sales promotion agency, had developed the "Decode & Win Game," in conjunction with Cox Interactive Media, using a patent-pending decoder device (game device) delivered through a direct mail campaign. The

Art Unit: 3622

direct mail piece was sent to a test cell of 7,000 FASTBALL.com users throughout the country (providing a game piece to the users). The mailing directed consumers to a special contest page within the domain of the FASTBALL.com on-line service (the communication or direct mail invited the users to visit the featured site and participate in a contest using the received or provided game piece). The Grand Prize for the "Decode & Win Game" or contest was a trip for two to any of the six newest baseball stadiums in the U.S. Other prizes included baseball memorabilia.

The FASTBALL.com "Decode & Win Game" **piece contained a hidden word** (camouflaged image), which was not visible without assistance (which cannot be decoded without special means). To decode the hidden word or to reveal the camouflaged image imprinted on the game piece, players or individuals interacted with the featured website when placing their game piece against a specially colored background (lit background) appearing in the FASTBALL.com/contest page to reveal the winning status of the game piece (placing the game piece in proximity of a light source or colored background to reveal the winning status of a game piece).

In addition, each game piece contained a unique account number to identify individual players and keep track of the number of times they visited the site (a game piece is unique). To participate, players entered their account numbers.

Each week for four weeks, a different word was selected as the winner.

Players were asked to enter each week for four weeks.

Participants in the FASTBALL.com promotion played an average of 2.1 times during the four-week period, with many returning each of the four weeks during the contest (reasonable

Art Unit: 3622

achievement).

Finally, the next step in the program requires FASTBALL.com to recruit sponsors for the national rollout of the "Decode & Win Game." In addition to direct mail, the national contest could be delivered through consumer print media, in-pack, on-pack, over-the-counter and at point-of-purchase (delivering contest invitation to potential users via a plurality of media).

### Conclusion

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

08/03/07

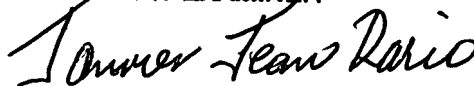
JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622

JEAN D. JANVIER  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Jean D. Janvier". The signature is written in a cursive, flowing style.